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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/615,135

07/08/2003

Harold I. Sussman

J203-005 CIP

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09/24/2004

NOTARO AND MICHALOS

100 DUTCH HILL ROAD

SUITE 110

ORANGEBURG, NY 10962-2100

EXAMINER

MANAHAN, TODD E

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,135

Applicant(s)

SUSSMAN, HAROLD I.

Examiner

Todd E. Manahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

The drawings are objected to because figures 13-19 are informal. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any

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required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-8 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 3, line 1, "the bridge portion" lacks a prior antecedent.

The terminology "no longer than the depth of a selected hole drilled in the jaw bone" in claim 15 is relative terminology which renders the claim indefinite. This terminology is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 9, 11, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Vaughan (United States Patent No. 3,869,803).

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Vaughan discloses a hole guide for use in drilling a hole comprising: an elongated metal engagement bar 20 having first and second opposite ends; a cylindrical drill guide bore 38 extending through the bar adjacent the first end for guiding a drill for drilling a hole (note pilot rod is removed prior to drilling); a first guide post 52 extending outwardly from the first surface of the bar adjacent the second end of the bar; and a second guide post 48 extending outwardly from the second surface of the bar adjacent the second end of the bar and coaxial with the first post. The first and second posts are parallel to the axis of the bore and spaced from the bore by a minimum center-to-center distance. Each of the posts has a diameter that is no larger than the diameter of a selected hole to be drilled. Regarding claims 3-5, one of the bolt holes would constitute an aperture in the bridge portion since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Regarding claim 13, the device of Vaughan is for drilling valve stem holes in an engine and as such, the spacing between the axis of the posts and the axis of the guide bore would inherently be larger than 7 mm.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abrahams (United States Patent No. 5,833,693).

Abrahami discloses an implant hole guide for use in drilling a hole in an edentulous area of a jaw bone in preparation for receiving a dental implant in the jaw bone, comprising: an elongated metal bone engagement bar 10 having first and second opposite ends, a first surface adapted to engage a jaw bone ridge area adjacent a site on a patient's jaw bone ridge for receiving the hole, and an opposite second surface; a cylindrical drill guide bore 24 extending through the bar from the first to the second surface and adjacent the first end for guiding a drill for drilling a hole into the jaw bone; a first guide post 25 extending outwardly from the first surface of the bar adjacent the second end of the bar; and a second guide post 14 extending outwardly from the second surface of the bar adjacent the second end of the bar and coaxial with the first post; the first and second posts being parallel to the axis of the bore; each of the posts having a diameter that is no larger than the diameter of a selected hole to be drilled into the jaw bone so that with the first post in a first selected hole in the jaw bone and the first surface engaging the jaw bone, the guide bore can be used to guide a drill for drilling a second selected hole in the jaw bone that is spaced from the first selected hole. Abrahami discloses the invention essentially was claimed except for the first and second posts being spaced from the bore by a minimum center-to-center implant distance which is sufficient to maintain at least 3 mm of jaw bone between adjacent implant receiving holes in the jaw bone. It would have been obvious to one having ordinary skill in the art at the time the invention was made to space the first and second posts from the bore by a minimum center-to-center implant distance which is sufficient to maintain at least 3 mm of jaw bone between adjacent implant receiving holes in the jaw bone, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Regarding claims 10 and 12, it would

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have been obvious to one having ordinary skill in the art at the time the invention was made to form the first post of about 2 mm in diameter and second post of about 3 mm in diameter, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims 1, 2, and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sussman (United States Patent No. 6,062,856).

Sussman discloses the claimed invention except for the first and second posts being spaced from the bore by a minimum center-to-center implant distance which is sufficient to maintain at least 3 mm of jaw bone between adjacent implant receiving holes in the jaw bone (see figures 5-8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to space the first and second posts from the bore by a minimum center-to-center implant distance which is sufficient to maintain at least 3 mm of jaw bone between adjacent implant receiving holes in the jaw bone, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)..

Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sussman '856 (United States Patent No. 6,062,856) as applied to claim 1 above, and further in view of Sussman '065 (United States Patent No. 5,888,065).

Sussman '065 discloses providing an aperture 54 in a drill guide for securing a safety string (note that screw 26 is part of the drill guide). It would have been obvious to one skilled in the art to provide the drill guide of Sussman '856 with an aperture in the bridge portion in view

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of Sussman '065 in order to permit a safety string to be attached thereto. Regarding claim 8, making the aperture polygonal would have been an obvious matter of design choice.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 703 308-2695. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T.E. Manahan
22 September 2004

Todd E. Manahan
Primary Examiner
Art Unit 3732

